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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/820,554

Applicant(s)

TANNENBAUM, DAVID H.

Examiner

Dominic D. Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. Thus the effective filing date of the instant application is July 27, 2000, the filing date of US application 09/625,646, now US Pat. No. 6,807,568.

### ***Claim Objections***

2. Claim 35 is objected to because of the following informalities: On line 1, "31" should be --33--.
3. Claim 40 is objected to because of the following informalities: On line 2 "said program, said program" should be changed to --said program--.
4. Claim 46 is objected to because of the following informalities: On line 2, "form" should be changed to --from--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-38 and 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US 2004/0117831 A1) [Ellis].

Ellis fully incorporates by reference US application 09/378,533, filed August 20, 1999, to McKissick et al. (shown in paragraph 134, referred to herein as 'McKissick', a copy of which is provided for convenience of the applicant).

Regarding claim 1, Ellis discloses a method for allowing a user to receive programs desired by said user, said method comprising the steps of accepting from said user information pertaining to a program desired to be viewed by said user, matching by other than said user, said accepted information against a list of known programs currently scheduled to be delivered, and informing said user as to when said programs will be delivered (McKissick, page 22 line 28 – page 23 line 15).

Regarding claim 2, Ellis discloses the method of claim 1, wherein said user is allowed to receive said programs at the informed time (McKissick, page 23, lines 16-32).

Regarding claim 3, Ellis discloses the method of claim 1, wherein said program information is selected from future programs (McKissick, page 23, lines 16-17).

Regarding claim 4, Ellis discloses the method of claim 1, wherein upon a non-match condition (McKissick, a “non-frame” program, or a program yet unscheduled, page 16, lines 1-10) making said user request available to at least one content provider (McKissick teaches impulse order for pay-per-view, page 18, lines 30-33, wherein the pay-per-view event has yet to be scheduled, page 24 line 8 – page 25 line 12 and also teaches unscheduled video-on-demand, page 34, lines 3-6).

Regarding claims 5 and 6, Ellis discloses the method of claim 4, wherein an interaction between said content provider and said user delivers content containing said descriptive material [the program that matches said descriptive material] to said user (McKissick, said user actively orders the program using the provided option, page 18, lines 30-33).

Regarding claim 7, Ellis discloses the method of claim 1, wherein upon a non-match condition, continuing by other than said user to match said accepted information against future lists of programs scheduled to be delivered (McKissick, page 27 line 31 – page 28 line 10).

Regarding claim 8, Ellis discloses the method of claim 1, wherein upon a non-match condition continuing by other than said user to match said accepted

information against possible future programs not yet scheduled (McKissick, page 15 line 29 – page 16 line 10).

Regarding claim 9, Ellis discloses the method of claim 1, wherein a recorder, at said user's location, is enabled to record said programs when matched ones of said programs are delivered to said user (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claims 10 and 11, Ellis discloses the method of claim 9, wherein the recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the specified program recording time is adjusted in accordance with the location of the user and in accordance with information concerning the actual transmission times of programs being recorded, otherwise the times set for recording would not be the correct times).

Regarding claim 12, Ellis discloses the method of claim 1, wherein said matching step includes comparing a program provider's identity against a permission level set by said TV user (Ellis teaches users set parental controls that block programs, ratings, and channels, paragraphs 196-199).

Regarding claim 13, Ellis discloses the method of claim 1, wherein said matching step includes interacting with said user (McKissick, page 25, lines 13-28).

Regarding claim 14, Ellis discloses the method of claim 1, wherein said accepting step includes accepting said program information over a network separate from the network used to deliver said desired program (McKissick, page 11, lines 5-19).

Regarding claim 15, Ellis discloses the method of claim 1, wherein said informing step includes informing said user via an electronic message communicated separate from the network used to deliver said desired program (McKissick, page 14 line 32 – page 15 line 8).

Regarding claim 16, Ellis discloses a system for delivering entertainment program to a user, said system comprising:

means for allowing said user to input and store desired programs  
(McKissick, page 23, lines 1-3);

means independent from said user's control for determining which, if any, of said stored desired programs are currently available to said user  
(McKissick, page 23, lines 6-15); and

means controlled in part by said determining means for informing said user that one or more of said stored desired programs are currently available and for subsequently informing said user that desired programs which were determined not to have been currently available to said user have become available (McKissick, page 22 line 28 – page 23 line 15 and page 15 line 29 – page 16 line 10).

Regarding claim 17, Ellis discloses the system of claim 16, wherein said determining means includes means for allowing a program provider to review determined unavailable desired programs to determine if said program provider can deliver to said user one or more of said unavailable desired stored programs (McKissick review of the list of desired programs takes place at the main facility or television distribution facility [both are program providers], wherein the facilities constantly check to see if a program moves into the current program guide time frame, at which point the desired program then becomes available for delivery from the program provider, page 16, lines 11-26).

Regarding claim 18, Ellis discloses the system of claim 17, wherein said informing means is at a first location (McKissick teaches notifications are sent from an Internet source, page 14 line 32 – page 15 line 8) and said program provider is at a second location remote from said informing means (while the



program provider is a television broadcast facility, as shown in fig. 1, facility 20, which is shown to be not connected to the Internet).

Regarding claim 19, Ellis discloses the system of claim 16, wherein said programs are future programs (McKissick, page 23, lines 16-17).

Regarding claim 20, Ellis discloses the system of claim 16, further including means for controlling recording times of delivered ones of said desired programs in according with the actual delivered time of such program at a user's location (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claims 21 and 32, Ellis discloses a method for allowing a TV user to receive programs desired by said user, said method comprising:

recording (in a memory), under control of said user, requests pertaining to a program desired to be viewed by said user, said desired programs not necessarily currently scheduled, either as stand alone programs or programs which are part of a series, for availability to said user (McKissick, page 22 line 28 – page 23 line 15);

accessing recorded ones of said requests by other than said user (McKissick, page 23, lines 6-9);

determining (by a processor), independent of control by said user, whether or not a program corresponding to an accessed request is currently scheduled so as to be available for delivery to said user (McKissick, page 23, lines 6-15); and informing said user as to the availability of an accessed request (McKissick, 'reminder list', page 23, lines 12-19).

Regarding claim 22, Ellis discloses the method of claim 21, wherein said user is allowed to receive said programs at the informed time (McKissick, page 23, lines 16-32).

Regarding claim 23, Ellis discloses the method of claim 21, wherein said requests pertain to future programs (McKissick, page 23, lines 16-17).

Regarding claim 24, Ellis discloses the method of claim 21, wherein upon a determination that there are no currently scheduled programs matching an accessed request (McKissick, a "non-frame" program, or a program yet unscheduled, page 16, lines 1-10) making said user request available to at least one content provider (McKissick teaches impulse order for pay-per-view from a content provider, page 18, lines 30-33, wherein the pay-per-view event from the content provider has yet to be scheduled, page 24 line 8 – page 25 line 12, and also teaches unscheduled video-on-demand, page 34, lines 3-6).

Regarding claims 25 and 26, Ellis discloses the method of claim 24, wherein an interaction between said content provider and said user delivers content containing said descriptive material [the program that matches said descriptive material] to said user when said corresponding programs are determined to be available for delivery to said user from said content provider (McKissick, said user actively orders the program using the provided option, page 18, lines 30-33).

Regarding claim 27, Ellis discloses the method of claim 21, wherein upon a determination that there are no currently scheduled programs matching an accessed request, continuing for a period of time said accessing, determining, and informing steps (McKissick, page 27 line 31 – page 28 line 10).

Regarding claim 28 and 29, Ellis discloses the method of claims 27 and 21, wherein a recorder, at said user's location, is enabled to record said programs when a match is determined with a subsequently scheduled program (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claims 30 and 31, Ellis discloses the method of claim 29, wherein the recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the specified program recording time is adjusted in accordance

with the location of the user and in accordance with information concerning the actual transmission times of programs being recorded, otherwise the times set for recording would not be the correct times).

Regarding claim 33, Ellis discloses the system of claim 32, wherein said memory is at a location remote from said desiring viewer (McKissick teaches the stored list to which the titles entered by a user are compared is located at a location remote from the viewer, page 16, lines 11-26, so memory that stores desiring viewer information is at the location remote from the viewer, enabling the comparison step).

Regarding claim 34, Ellis discloses the system of claim 33, wherein said processor is operable to handle multiple desiring viewers (McKissick shows in fig. 1, plural users are connected to the main facility and television distribution facility, so the processor remote from the desiring viewer is operable to handle the plural disclosed users).

Regarding claim 35, Ellis discloses the system of claim 33, wherein said processor is further operable in response to a determined match for enabling a recorder to capture said matched program content (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claim 36, Ellis discloses the system of claim 33, wherein said recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the specified program recording time is adjusted in accordance with the location of the user and in accordance with information concerning the actual transmission times of programs being recorded, otherwise the times set for recording would not be the correct times).

Regarding claim 37, Ellis discloses the system of claim 33, wherein said recorder is enabled at a location specified by said desiring viewer, said specified location not necessarily being located at the location of said desiring viewer when said desiring viewer stores said viewed information (McKissick, page 30, lines 1-3, wherein said recording enabling notifications may be set up from a remote location, page 34, lines 21-32).

Regarding claim 38, Ellis discloses the system of claim 32, wherein said processor is further operable in response to a determined match for informing said user of said match when said match has been determined (McKissick, page 23, lines 10-16).

Regarding claim 45, Ellis discloses a method for controlling TV program recording by a viewer, said method comprising:

storing programs desired by said viewer (McKissick, page 13, lines 23-32 and page 30, lines 1-3);

matching, under control independent of said viewer, program content being delivered to said viewer (McKissick, page 22 line 28 – page 23 line 15); and

adjusting a time span of a recorder enabled to record said program content, said adjusting being in accordance with an actual program time span (McKissick teaches programming the recorder so that it starts and stops recording at the appropriate times, page 13, lines 30-32).

Regarding claim 46, Ellis discloses the method of claim 45, wherein said adjusting comprises adjustments including change of start time (the recorder is directed to start recording at the appropriate time, McKissick, page 13, lines 27-32).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Durden et al. (5,003,384) [Durden].

Regarding claim 39, Ellis discloses a system for delivery of TV programs to a viewer, said system comprising:

a communication link from a desiring viewer (McKissick, fig. 1, communication lines 30 and 32);

memory accessible over said communication link by a plurality of desiring viewers for storing from any one or more said desiring viewers information pertaining to the delivery of one or more desired programs (McKissick teaches entered titles are compared to a list of programs, stored remotely from the viewers, wherein the search occurs where is the list is stored, thus including a memory remote from the viewers that stores the titles submitted by said viewers, page 16, lines 11-26);

a processor for comparing stored ones of said viewer information against program content information as said program content information becomes available to determine matches therebetween on a viewer by viewer basis (McKissick, page 16, lines 11-26); and

wherein said processor is further operable in response to a determined match for individually informing each said viewer as to matches relevant to said viewer (McKissick, comparison step creates the 'notifications list', page 16, lines 11-26, wherein the notifications are sent to viewers, page 17, lines 19-34).

Ellis fails to disclose said delivery is to a location specified by each said desiring viewer.

In an analogous art, Durden teaches allowing users to make requests for pay per view events from locations remote from their homes, wherein they must specify to which home the pay per view event is to be authorized during the order (col. 11, lines 57-65 and col. 12, lines 36-63), for the benefit of pre-ordering pay per view events while away from home.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Ellis to include said delivery is to a location specified by each said desiring viewer, as taught by Durden, for the benefit of allowing user to pre-order programming while away from their receivers.

Regarding claims 40 and 42-44, Ellis and Durden disclose the system of claim 39, wherein said processor is further operable for individually informing each said viewer as to the times of said program (McKissick, shown in fig. 6) and setting a recorder to record a program (McKissick, page 13, lines 23-32 and page 30, lines 1-3) at the location specified by the viewer (as taught by Durden, shown above regarding claim 39), but fails to disclose said time information is adjusted for the location of said viewer.

Examiner takes official notice that it is notoriously well known in the art to adjust times for time zone differences, in order to properly display the correct time.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Ellis and Durden to include adjusting said



time information for the location of said viewer, for the benefit of providing a time indication that is accurate relative to the viewer who receives the notice.

Regarding claim 41, Ellis and Durden discloses the system of claim 39, wherein said processor is further operable for individually information each said viewer as to the time span of said program (the processor provides the program guide which specifies the time spans of schedule programs, including the viewer requested program, McKissick, fig. 18a and page 10 line 18 – page 11 line 19).

### ***Conclusion***

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli  
Patent Examiner  
Art Unit 2611

DS



HAITRAN  
PRIMARY EXAMINER